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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gi-Go Toys Factory Ltd.

Serial No. 76/000,138

Anthony O. Cormier, Esq. for Gi-Go Toys Factory Ltd.

Rebecca A. Smith, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Hanak, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 15, 2000, Gi-Go Toys Factory Ltd. (applicant)
filed an application¹ to register the mark MY LITTLE DREAM
GIRL, in typed form, on the Principal Register for goods
identified as "dolls and doll accessories" in International
Class 28.

The Examining Attorney refused to register the mark on
the ground that there would be a likelihood of confusion

¹ Serial No. 76/000,138. The application contains an allegation
of applicant's bona fide intention to use the mark in commerce.

between applicant's mark for its goods and the mark DREAM GIRL, in typed form, for "dolls, doll clothing and doll accessories" in International Class 28.²

After the examining attorney made the refusal final, this appeal followed. Both applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney's position is that the marks are highly similar in that applicant has taken the registered mark DREAM GIRL and merely added the words "My Little" to registrant's mark. "The terms 'MY LITTLE' comprise subordinate matter since the dominant portion of the marks are the terms DREAM GIRL. These terms add little to the mark and consumers are likely to remember the terms 'dream girl' when calling for the goods." Examining Attorney's Br. at 5. When applicant's identification of goods is for goods identical to those found in the identification of goods in the registered mark (dolls and doll accessories), the examining attorney held that there would be a likelihood of confusion.

Applicant, on the other hand, argues "DREAM GIRL implies a young women whom a suitor would desire or about whom a suitor would have a fanciful vision. The addition of the words MY LITTLE changes the reverie entirely. With

² Registration No. 2,084,474, issued July 29, 1997.

those words added the subject suggested becomes a child rather than a young women." Applicant's Br. at 6. Applicant concludes by arguing that "[s]ince in this case the field is extremely crowded and since the marks are different in both composition and suggestive meaning, ... there is no compelling reason to infer likelihood of confusion." Id. at 7.

We affirm the refusal to register under Section 2(d).

Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we will consider is whether the goods are related. In this case, applicant's goods are dolls and doll accessories. These identical goods are included in registrant's identification of goods (dolls, doll clothing

and doll accessories). "Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods." Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Since both the goods of registrant and applicant include dolls and doll accessories, we must assume that these goods would move through all normal channels of trade and be sold to the same consumers. See Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of Squitco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration").

Next, we consider whether the marks are similar in sound, appearance, meaning or commercial impression. du Pont, 177 USPQ at 567. Registrant's mark is DREAM GIRL; applicant's mark is MY LITTLE DREAM GIRL. Applicant has taken the entire registered mark and added the words "My Little" to it. We agree with applicant's point that "the effect of adding or deleting a term must depend on the facts of each case." Applicant's Br. at 5. However, "there is a general rule that a subsequent user may not appropriate another's entire mark and avoid a likelihood of

confusion therewith by merely adding descriptive or otherwise subordinate material to it. An exception may be found in those cases where the appropriated mark is highly suggestive or descriptive or has been frequently used by others in the field for the same or related goods or services." In re Rexel Inc., 223 USPQ 830, 832 (TTAB 1984) (citations omitted).

Applicant argues that its "evidence" shows "the extremely common usage of the words as trademarks and thus the limited scope of protection of the word as trademarks." Applicant's Br. at 5. We disagree. Applicant has submitted printouts of records from the Office's automated database³ from which applicant concludes that the registered

³ The examining attorney states that "applicant has provided copies of registered marks" (Office action dated May 31, 2001, p. 2) and "applicant has provided copies of registrations" (Examining Attorney's Br. at 4). If applicant has provided copies of the registrations or registered marks, they are not in the file. What applicant itself says it has provided are three exhibits consisting of lists of records from "a TESS search." Applicant's Br. at 6. Exhibit A is a list of 50 of 3124 records containing the word "dream" or "dreams;" Exhibit B is a list of the first 50 of 3210 records containing the word "girl" or "girls;" and Exhibit C is a list of 20 records containing the words "dream girls."

The examining attorney does not object to the lists or advise applicant that a mere listing of registrations is not sufficient to make them of record. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"); See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994); In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). We, therefore, accept the lists for whatever probative value they may have.

mark is weak. The probative value of these lists is near zero. The lists themselves consist of columns containing the serial number, the registration number, the mark, and a Live/Dead indicator. Lists A and B do not contain a single registration number. The fact that an application has been filed with the Office hardly justifies the registration of applicant's mark. Exhibit C lists 9 applications and 11 registrations. Six of the nine applications are listed as "dead." One application is applicant's. Of the eleven registrations listed, six are identified as dead and one is the cited registration. "[A] canceled registration does not provide constructive notice of anything." Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). Furthermore, it is not surprising that a mark can register over an expired registration. Therefore, applicant's evidence consists of the fact that there are a total of four other registrations for the term "DREAM GIRL" in all classes of goods and services. This is hardly noteworthy. If the evidence of four other registrations in all classes for the same term is at all relevant, it would tend to support the strength of the term, and not its weakness. Even if these lists demonstrated that the cited mark is weak, it is still entitled to protection when very similar marks are used on

the identical goods. In re Colonial Stores, Inc., 216 USPQ 793, 795 (TTAB 1982) (“[E]ven weak marks are entitled to protection against registration of similar marks”).

The only difference between the marks is the additional term “My Little” in applicant’s mark. Applicant argues that this creates different commercial impressions, with the registered mark suggesting a young woman and applicant’s mark suggesting an infant girl. We do not see that the commercial impressions of the marks are significantly different. The term “girl” in the registered mark is not limited to a girl of any particular age so the commercial impressions of the marks could be the same, a girl who is a dream. Applicant’s addition of the “My Little” to “Dream Girl” simply provides subordinate information about the dolls. His additional language may also suggest that the dolls are a smaller version of the original dolls. Even a much more incongruous use of the term “little” did not avoid a likelihood of confusion. Rexel, 223 USPQ at 832 (LITTLE GOLIATH for stapler kits held to be confusingly similar to GOLIATH for pencils despite the claim that “Little” combined with “Goliath” was not subordinate matter because it was oxymoronic). Therefore, the addition of the words “My Little” does not change the commercial impression of the marks. They look

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and sound similar and they would have similar meanings. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(holding that THE DELTA CAFE and design was confusingly similar to DELTA; more weight given to common dominant word DELTA). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products); Squirtco, 216 USPQ at 939 ("The marks SQUIRT and SQUIRT SQUAD are, however, of such similarity that they are more likely to create confusion than prevent it"). A prospective purchaser could easily believe that there is a common source for dolls and doll accessories sold under the marks DREAM GIRL and MY LITTLE DREAM GIRL.

Another factor that supports our conclusion is the principle that, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Here, applicant's goods are identical to goods in the registered mark. Therefore, the marks do not need to be as close to find that there is a likelihood of confusion.

Finally, even if we had doubts about the issue of likelihood of confusion, we must resolve them against applicant.

If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant. The rule is usually applied in inter partes cases but it applies equally to ex parte rejections.

In re Pneumatiques, Caoutchouc Manufacture et Platitudes Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973). See also Dixie Restaurants, 41 USPQ at 1535 ("Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks").

Therefore, when the marks DREAM GIRL and MY LITTLE DREAM GIRL are used on dolls and doll accessories, there would be a likelihood of confusion.

Decision: The Examining Attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registration under Section 2(d) of the Trademark Act is affirmed.